

HEINRICH GERS-BARLAG ET AL.  
USSN 08/987,468

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CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants wish to address the showing required under 37 CFR §1.116(b) as to why the amendments above are necessary and were not presented earlier. The amendments above are necessary to correct obvious typographical errors. Such errors were inadvertently introduced in the amendment filed on April 6, 1999, and were not recognized until now. Accordingly, for this reason, and also because this is the first paper filed since the amendment of April 6, 1999, these

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amendments could not have been presented earlier. In view of the foregoing, Applicants respectfully request that the Examiner enter and consider these amendments.

Before addressing the substantive matters in the final rejection, Applicants respectfully request that the Examiner withdraw the finality thereof as being premature. On page 5 of the final rejection, the Examiner indicates that Applicants' amendment necessitated the new grounds of rejection. However, the final rejection contains a new obviousness-type double patenting rejection on page 3 thereof, and there is absolutely nothing in Applicants' amendment that necessitated such rejection being made for the first time in the final rejection. The Examiner's explanation of the rejection leaves no doubt whatsoever that the rejection would have been applicable against previous claims 1, 2 and 4-11, which were treated in the first Office Action on the merits. Accordingly, this same rejection could have been presented in the first Office Action on the merits, and, consequently, Applicants' amendment did not necessitate this particular new ground of rejection in the final rejection. MPEP § 706.07(a) is quite clear that "[u]nder present practice, second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee

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set forth in 37 CFR 1.17(p)." As noted above, Applicants' last amendment did not necessitate the new obviousness-type double patenting rejection. Also, the obviousness-type double patenting rejection is not based on information supplied in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Accordingly, the final rejection is clearly premature, and Applicants respectfully request that the finality of it be withdrawn.

The original declaration was again objected to as being defective. In response, Applicants note that they argued in the paragraph bridging pages 10-11 of the amendment dated April 6, 1999, that the declaration should be accepted because the language used embraced the language required by the applicable rules, and, therefore, Applicants did, in fact, make the required acknowledgement. The Examiner does not respond to Applicants' argument at all in the final rejection, and Applicants therefore request that the Examiner reconsider this point, and withdraw this requirement based on that argument. An early notice that this requirement is withdrawn is earnestly solicited.

Claims 12-26 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,876,702. In response, Applicants emphasize that the focus of this rejection should be on the claims. However, the Examiner focuses much attention

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on the disclosure of the '702 patent, which Applicants submit is improper. Thus, for example, claims 12-20 of the '702 patent are included in this rejection, but such claims relate to a process of incorporating sparingly soluble UV filter substances into emulsions. None of the instant claims are drawn to such a process. Accordingly, grant of the present claims could not possibly improperly extend the monopoly granted on such process claims.

Likewise, the instant claims are drawn to finished sunscreen formulations and methods of increasing the water resistance of finished sunscreen formulations. In contrast, claims 1-11 of the '702 patent are drawn to emulsions, and, moreover, are not required to contain any of the same ingredients required by the present claims. Accordingly, it is also unclear how grant of the present claims would improperly extend the monopoly granted on such emulsion claims.

Claims 12-26 were rejected under 35 USC § 103(a) as being obvious over Gers-Barlag et al. ("Gers-Barlag"), U.S. Patent No. 5,725,844, in view of Grollier et al. ("Grollier"), U.S. Patent No. 5,427,771. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. The Court recently held in In re Geisler, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997), that a prima facie case of obviousness "can be rebutted if the applicant (1) can establish 'the existence of unexpected properties in the claimed range' or (2) can show 'that the art in any

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material respect taught away' from the claimed invention (emphasis added.)" The Examiner concedes that Gers-Barlag does not specifically teach polyglyceryl emulsifiers. Indeed, the examples therein, which must be considered Gers-Barlag's most preferred embodiments, utilize monoglyceryl emulsifiers. Accordingly, Gers-Barlag actually leads away from the present invention.

Grollier is cited in support of this rejection, and, while it is true that both Grollier and Gers-Barlag relate to sunscreen formulations, Gers-Barlag is related to specially formulated water-resistant sunscreen formulations. There is nothing in Grollier that would lead persons skilled in the art to expect that polyglyceryl emulsifiers should be useful in Gers-Barlag's formulations. Therefore, Grollier does not actually remedy the deficiencies of Gers-Barlag.

In short, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing adequately deals with all outstanding objections and rejections.

Applicants further believe that this application is now in condition for

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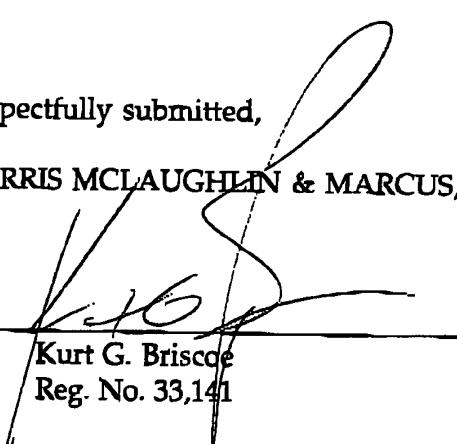
immediate allowance. However, should any issues of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (914) 332-1700 so that the issues might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS MC LAUGHLIN & MARCUS, P.A.

By

  
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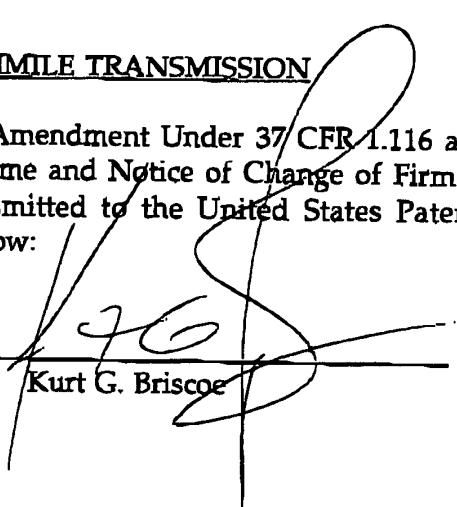
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment Under 37 CFR 1.116 and the accompanying Petition for Extension of Time and Notice of Change of Firm Name (11 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date December 3, 1999

By

  
Kurt G. Briscoe